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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,958	01/18/2006	Prakash Patel	056258-5127	5382

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT PAPER NUMBER

1755

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/564,958

Applicant(s)

PATEL, PRAKASH

Examiner

Helene Klemanski

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/18/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The references cited in the Search Report dated October 18, 2004 have been considered.

Specification

2. The abstract of the disclosure is objected to because it is more than one paragraph in length. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2 and 17, the phrase "in the presence of a suitable nitrogen source (if required)" is considered vague and indefinite because it is unclear whether the limitations preceding the phrase are part of the claimed invention. See MPEP 2173.05(d). The use of this phrase suggests that the claimed composition may be produced to the desired end product with or without the inclusion of those components (i.e. limitations). Therefore, one must resort to conjecture to ascertain applicants

intended point. The examiner suggests the deletion of the term "(if required)" and adding the phrase "optionally in the presence of a suitable nitrogen source" in its place to overcome the rejection.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-40 of copending Application No. 10/564,935. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

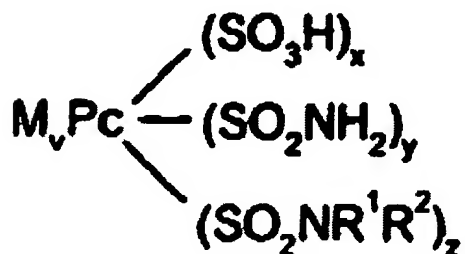
Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 4-16 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/67334.

WO 99/67334 teaches compounds of the formula



wherein M represents a metal such as Cu or Ni; Pc represents a phthalocyanine nucleus; R¹ represents H or -(CH₂)_nR³; R² represents -(CH₂)_nR³ or R¹ and R² together with the nitrogen atom to which they are attached represent a 5- or 6-membered ring; n is independently an integer from 1-30; R³ is independently a group selected from hydroxy, sulphy, cyano, -SR⁴, -CO₂R⁵, -PO₃H₂ and -NR⁶R⁷; R⁴-R⁷ independently represent H, C₁₋₃₀ alkyl optionally substituted by one or more groups selected from hydroxy, mercapto, sulphy, carboxy, cyano and -PO₃H₂; v is the valence of Pc divided by the valence of M; x is from 1.2-3.8; y is from 0.1-2.7; z is from 0.1-2.7 and x, y and z satisfy 2 ≤ x+y+z ≤ 4. The above formula includes all chemical and physical forms

thereof (i.e. β -substitution). WO 99/67334 also teaches an ink jet ink composition comprising 0.01 to 30 parts by weight of at least one of the above phthalocyanine compounds as the colorant (i.e. dye mixture) and 70-99.99 parts by weight of a liquid medium. WO 99/67334 further teaches a process for printing comprising ejecting the above ink jet ink composition onto a substrate. See page 1, line 25 – page 2, line 31, page 3, lines 5-30, page 4, lines 28-38, page 5, lines 25-32, page 7, lines 4-5, page 9, lines 3-20, examples 1-15, page 15, lines 10-23, Tables I-IX and claims 1 and 3-5. WO 99/67334 fails to specifically exemplify that the substituents on the phthalocyanine ring are in the β -position or an ink containing a mixture of phthalocyanine dyes as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific β -substituted phthalocyanine dye and an ink containing a mixture of phthalocyanine dyes as claimed by applicants as WO 99/67334 also discloses the use of these β -substituted phthalocyanine dyes and mixture of phthalocyanine dyes but fails to show an example incorporating them.

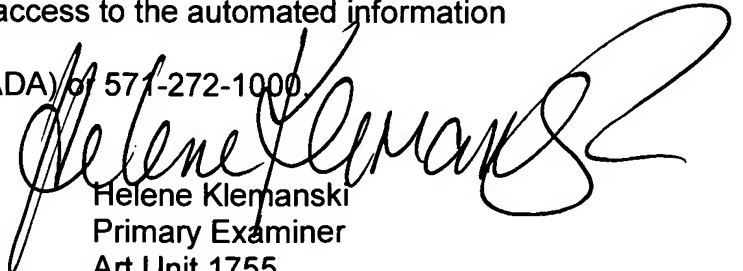
Conclusion

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Helene Klemanski
Primary Examiner
Art Unit 1755



HK
June 25, 2006